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EXAMINER

CHURCH, CRAIG E

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2882

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Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL EXAMINER'S ANSWER

While the Board's remand asserts that the examiner's answer includes the "development of new issues", it lacks the wisdom and candor to delineate what they are. The DeSena patent was cited on The Notice Of References Cited and applied in the claim rejections in its entirety and not in a piecemeal manner as seems to be construed by the board. In fact the DeSena patent has been applied against the appealed and similar claims since March of 1998 in no less than six separate actions (copies attached). The issue is a simple fact of nature, and it has not changed since 1998. That is, the amount of x-ray absorption of an object of any composition increases with the object thickness. Conversely, the amount of x-rays that pass through the same object increases as the thickness of the object decreases. This is a law of physics that is known to the very novice physicist, and it cannot be altered by section 132 declarations.

The record should further show that examiners are not permitted by Office policy to respond to reply briefs. Nonetheless, examiner will earnestly comply with what he perceives the Board's directive to be.

The Answer

The detailed reading of claim 20 on DeSena referred to in the remand is direct rebuttal to appellant's arguments in his brief that the claim distinguishes over the patent and is thus not a new issue.

The Reply Brief

Page 2 repeats the proclamation that DeSena suggests that his markers are of a material that is "radiopaque", and appellant would have us believe that this

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means a material that blocks (absorbs) 100% of all x rays at all energies. And as has been observed previously "radiopaque" is synonymous in the art with --x-ray absorptive-- and does not mean that it will not pass some radiation as asserted by appellant. More importantly and irrefutably, DeSena's markers are made of aluminum (lines 11-13 of column 3) as are appellant's (claim 21). Appellant has been challenged previously to explain how his aluminum differs from DeSena's, but HE HAS FAILED TO DO SO.

Appellant insists at length (pages 2-5) that the DeSena markers are configured for podiatry. While this position is correct, it is totally immaterial since appellant's claims do not exclude his markers from podiatry. Nor is there any reason to believe that DeSena's markers may not be employed in general radiography, and appellant has offered no evidence to support such a premise. Again, the question to be judged is whether or not DeSena teaches an adhesively applicable x-ray marker that is partly opaque (ie partly translucent).

Similarly pages 6 and 7 seek to pull attention away from the relevant portions of the DeSena teaching by fixating on DeSena's desire to encompass the region of interest. DeSena simply wants to ensure that a physician examining the radiograph including marker images does not overlook an important anomaly which could easily occur if the region was marked only by an arrow (which would not encompass). This is explicitly explained in lines 48-58 of column 1

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of the patent and has no bearing on radiopacity of the marker as argued by appellant.

The issue to be resolved, then, is whether or not DeSena's marker is partially radiolucent, partially radiopaque. The desired performance of DeSena's marker is outlined in lines 24-31 of column 1 and is the same as that defined in appealed claim 20:

Highlighting the area of interest with a marker that is easily seen on the radiograph focusses the podiatrist's attention and thus aids in determining the course of treatment. Failure to so mark the radiograph, or marking in such a way that even small portions of the area of interest are obscured may seriously hinder the diagnostic examination of the problem area.

While lines 62-65 of column 4 of DeSena explain:

In the preferred embodiment said aluminum is deposited onto said adhesive tape 1 to a thickness sufficient to highlight an area of interest with clarity.

In other words, the degree of opacity or x-ray absorption is a function of the thickness of the deposited aluminum, and DeSena instructs that the thickness or absorption is just enough to make the marker visible in the image but not to obscure details should it inadvertently be placed over a vital region beneath the skin. The last paragraph of page 7 of the brief grossly misrepresents the DeSena teaching in alleging that the "thickness" discussed in column 4 of the patent refers to "line" thickness. Nowhere does DeSena even allude to marker line thickness. Rather lines 52-69 of the column describe a process by which aluminum is vapor deposited through a stencil onto the adhesive tape:

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Said aluminum is then vapor deposited through said stencil and onto said adhesive tape 1. In the preferred embodiment the aluminum is deposited on to said adhesive tape 1 to a thickness sufficient to highlight an area of interest with clarity.

Appellant's representation that "thickness" here refers to marker line thickness is absurd and unsupported by evidence or logic. Rather during vapor deposition the size of the marker and the width of its lines are governed by the pattern formed in the stencil, and "thickness" unequivocally refers to the depth of the aluminum layer that is being deposited which in turn determines the degree of radiopacity.

Furthermore, the wide range of thickness/absorption claimed by appellant (2-75%) is a clear proclamation that the thickness (and radiopacity) is not critical to the invention and that it is subject to the whim of the radiologist.

Pages 8 and 9 repeat arguments appearing earlier in the brief.

The Declaration Of Commercial Success

The commercial success advanced by appellant is not germane simply because the only limitation lacking in the DeSena disclosure is the specific statement that the marker must be less than 0.4 inches thick, and DeSena explicitly explains that the marker must be flexible, which means that it cannot be aluminum and be that thick. The "obviousness" issue here is not obviousness to modify a prior art device as argued by appellant but rather obviousness that the prior art device is the same as the device being claimed.

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Even though the Zielanski declaration alleges increasing sales of the Light Image Markers, the table at the bottom of page 3 shows an apparant drop in sales from 42001 boxes in 2000 to only 35744 in 2001 which is even fewer boxes than in 1999. This trend does not comprise success and does not support appellant's claim of patentability. Appellant's increased sales from 1997 to 2000 have have resulted from a competitor going out of business and not from alleged product advantages.

Page 4 asserts that in one year appellant achieved a 50% market share in mammographic markers, but no evidence is offered, and what was the market share in other years? Did it go down in 2000 and 2001 as suggested by the table at the bottom of page 3? It might be argued that a 50% market share is only a mediocre showing, especially if there were only two vendors of mammographic markers.

Page 5 refers to communications from customers praising appellant's product, but no copies thereof have been submitted, and a link to nonobviousness is not suggested.

It is noted that exhibits A, B, and C depict product pricing for appellant's A Spots, O Spots and S Spots markers respectively, but there is no explanation of how this information relates to appellant's stand on nonobviousness.

Observations

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Although pages 9 and 10 argue claims other than 20, appellant has stated that the claims stand or fall together, and the answers have dealt with claim 20 as being the first claim of record.

Pages 11 and 12 traverse an inherency rejection, but no such rejection has been made.

A handwritten signature in black ink that reads "Craig E. Church". The signature is written in a cursive, slightly slanted style.

**Craig E. Church
Senior Examiner
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